



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,423	09/27/2001	Klaus-Peter Jonderko	206033US0	8759

22850 7590 11/20/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
----------	--------------

1731

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/963,423	Applicant(s) JONDERKO ET AL.	
	Examiner Rabon Sergeant	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 13-25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11, 13-21, 25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1711

1. Amended claims 22-24 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 22-24 are directed to a dispersion comprising the blocked polyisocyanate adduct of claim 2; therefore, the subject matter of claim 2 is considered to be related to the subject matter of claims 22-24 in the form of an intermediate-final product relationship. Since the intermediate blocked polyisocyanate adduct is useful in the production of products other than dispersions, such as moldings, distinctness has been proven.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-24 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Claims 2-11, 13-21, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language, "obtainable by", fails to particularly point out and distinctly claim the invention since one cannot determine from the phrase just which compositions are "obtainable by" applicants process and which are not.

3. Claims 2-11, 13-21, 25, 27, and 28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the production of solid, pulverulent, water dispersible, blocked polyisocyanate adducts, wherein the percent contents of the reactants

Art Unit: 1711

correspond to those disclosed, does not reasonably provide enablement for the production of solid, pulverulent, water dispersible, blocked polyisocyanate adducts utilizing any percent composition of reactants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Applicants have failed to provide adequate enablement for the production of viable solid, pulverulent, water dispersible, blocked polyisocyanate adducts utilizing percent compositions of reactants other than those disclosed. One of ordinary skill could not practice the invention as claimed without resorting to undue experimentation.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

Art Unit: 1711

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2-11, 13-20, 25, 27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Reiff et al. ('370 or '482 or '737).

The references disclose the production of blocked isocyanates, wherein the blocked isocyanates are the reaction product of polyisocyanates, which meet applicants' claimed isocyanates; active hydrogen compounds containing ionic or potential ionic groups, which meet applicants' claimed ionic agents; polyols, which meet applicants' claimed polyols; blocking agents, which meet applicants' claimed blocking agents; and neutralizing agents, which meet applicants' claimed neutralizing agents. See abstract and columns 2-12 within Reiff et al.

6. Applicants have argued that the references fail to disclose water dispersible, blocked polyisocyanate adducts in the form of solid, pulverulent material. The examiner has considered applicants' argument; however, given the extent to which the argued terms are defined, the position is taken that Reiff et al. disclose embodiments of the invention that satisfy the argued language. Even in the form of a dispersion, the disclosed blocked polyisocyanate adducts are in the form of discrete particles. See column 12, line 10 within the ('737) reference, for example.

Art Unit: 1711

Therefore, in the absence of further definition by applicants, the position is taken that the disclosed term, "particles", is clearly suggestive of that which is solid and pulverulent.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reiff et al. ('370 or '482 or '737) further in view of Lange et al. ('805).

As aforementioned, the references disclose the production hydrophilic group containing, blocked polyisocyanates; however, the references are silent with respect to the addition of hydrophobic blocked polyisocyanates. Still, the position is taken that it would have been obvious to incorporate a quantity of hydrophobic, blocked isocyanates into the composition, because the addition of hydrophobic, blocked polyisocyanates to a hydrophilic, blocked polyisocyanate composition was known at the time of invention, as a means of easily incorporating the hydrophobic isocyanate into an aqueous polyurethane forming composition. See column 5 within Lange et al.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

Application/Control Number: 09/963,423

Page 6

Art Unit: 1711

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

November 17, 2003